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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,086	03/02/2001	Kenichi Yoshikawa	SPO-582	4655

7590

04/03/2003

Sherman & Shalloway  
413 North Washington Street  
Alexandria, VA 22314

EXAMINER

ZALUKAEVA, TATYANA

ART UNIT

PAPER NUMBER

1713

10

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,086

Applicant(s)

YOSHIKAWA ET AL.

Examiner

Tatyana Zalukaeva, Ph.D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-24 are amended; claims 25-28 are cancelled in paper No. 9
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-28 stand rejected under 35 U.S.C. 102(b) as being anticipated by or in alternative as obvious over WO 91/16376.

WO'376 discloses a packaging film with good clinging properties comprising a terpolymer of at least 50% of ethylene, 2-20% by weight of an unsaturated monocarboxylic acid having 3-8 carbon atoms and 2-20% of a moiety derived from at least one alkyl acrylate, alkyl methacrylate and mixtures thereof, wherein alkyl radical contains 2-12 carbon atoms (see page 3, lines 25-34). The low level of sorbitan fatty acid ester can be added to improve antifogging properties (see page 7, lines 9-19). This **expressly** meets all the limitations of the instant claims in terms of the identity and amounts of components of a composition. Antifogging additive is present in a composition (page 6, line 27).

WO'376 further teaches that the acid groups of the polymer of the acid containing moiety are neutralized 0-10% by at least one metal ion (see page 3, line 35 and page 4, line 1). Suitable metals are metals of Group I, II and III, out of which Zinc and Sodium are most preferable. (see page 6, lines 1-13). With regard to the stretching properties of the films, since the films of WO'376 are identical in their chemical make-up to the

instantly claimed films and are made by essentially the same method as instantly claimed films, such properties inherently present in the films of WO'376. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties **are inseparable**. Therefore if the prior art teaches the identical chemical structure, the properties and characteristics applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990).

The above rejections were also made in the sense of In re Fitzgerald or In re Spada, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions **are not novel**, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. The properties not disclosed in the cited reference are believed to be inherent for the compositions identical to those instantly claimed.

4. Claims 19-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO'376.

The above claims are **product-by-process** claims, wherein the limitation not disclosed in WO'376 is that the film is made by a T-die method. However, in terms of the chemical components and their amounts in a terpolymer the films of WO'376 and the instant claims are identical, which was addressed in the 102 (b) rejection. Furthermore, both films are prepared by an extrusion method, the non-specified difference is the shape of die. Applicants are reminded that patentability of the product is based on the product

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formed –not by method by which it was produced , *In re Thorpe*, 777 F 2d 695, 227, USPQ 964 (Fed. Cir 1985)

Furthermore, because of the nature of product-by process claims, the Examiner cannot ordinarily focus on the precise difference between the claimed product and the disclosed product. It is then Applicants' burden to prove that an unobvious difference exists. See *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983).

See also footnote 11 O.G. Notice 1162 59-61, wherein a 35 USC 102/103 rejection is authorized in the case of product-by-process claims because the exact identity of the claimed product or the prior art product cannot be determined by the Examiner.

*In re Brown*, 173 USPQ 685 (CCPA 1972), the Court of Customs and Patent Appeals (CCPA) explicitly approved the 102/103 rejection of a product-by-process claim over a reference which showed a product which appeared to be identical or only slightly different from the claimed product.

### ***Response to Arguments***

5. Applicant's arguments filed January 22, 2003 have been fully considered but they are not persuasive. The crux of Applicants' arguments appears to hinge on the **present amendment** to claims 1-14 that allegedly removes the reference WO'376 from the scope of 35 USC 102 rejection.

However, even as presently amended nothing is changed in terms of the chemical identity and amount of ingredients in a claimed composition,

As discussed in the previous and present Office Actions, the chemical identity of a composition and its properties are unseparable. *In re Spada*, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990). In alternative the rejection is made under 35 USC 103(a) shifting a burden to Applicants to show how the composition identical to the instantly claimed one can have different physico-mechanical properties, and if there is something in a composition that makes it distinguishable from the composition of the prior art, Applicants could have shown it on this record.

With regard to Applicants' argument on page 9, that the claimed range is unobvious because it is not a result effective variable it is noted that it unobvious because it is anticipated, as acknowledged by Applicants on page 9 of Paper No.9, lines 9-11.

With regard to the argument that WO'376 fails to teach the limitation of neutralizing with alkali metal, with all due respect to Applicants' opinion, Applicants attention is drawn to page 6, lines 4-6, especially lines 13, wherein sodium is exemplified, and line 16, wherein stated that neutralization is desirable to improve such characteristics as, melt stability. With regard to Applicants' reference to a specific example that does not present the claimed limitation in its details, it is noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843

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(Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva, Ph.D whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-24-50. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



**Tatyana Zolotareva, Ph.D.**  
**Primary Examiner**  
**Art Unit 1713**

March 27, 2003